

REMARKS

The Advisory Action of October 3, 2007, has been carefully reviewed.

The examiner states in the Advisory Action that newly amended/added claims 17-18 recite the phrase preparing a DNA which "consists" of an inverted repeat sequence and takes the position that the instant specification does not utilize the term "consist" or "consists" or "consisting" except in one circumstance and thus is not used to delineate structural requirements to the inverted repeat sequences, as used in the newly proposed claims.

This position is not understood. The terms "consisting of" and "comprising", which are used in claim language are discouraged from being used in the specification by the USPTO. It is common practice to use the closed claim language "consisting of" or "consists of" to limit the claims, even if such language is not used in the specification, in order to distinguish from the open claim language "comprising". Accordingly, there is absolutely no new matter being introduced into the claims by the use of the claim terminology "consists of" or "consisting of" in new claims 17 and 18.

The recitation of a spacer in claims 17 and 18 clearly must be a DNA spacer as the claims specifically recite "preparing a DNA which consists of... an inverted repeat sequences consisting

of". This spacer is simply an arbitrary sequence separating the sense and antisense strand sequences.

The examiner also takes the position in the Advisory Action as a "continuation of 11" that figures 14, 15 and 20 of Graham show that the promoter region of the vectors comprising the inverted repeat region lie outside the inverted repeat sequences, and therefore still read on a closed language phrase wherein the "DNA consists of an inverted repeat sequence of a sense strand and an antisense strand" since a promoter region could lie outside of the closed inverted repeat region for introducing mutations as taught by Graham.

With due respect to the examiner, this position is not logical. Applicants do not see how a promoter that may lie outside the inverted repeat sequence can read on a DNA which consists of an inverted repeat sequence consisting of a sense strand sequence and an antisense strand sequence with optionally a spacer sequence in between. The closed claim language excludes anything outside of the inverted repeat sequence, including a promoter. This is not language that is open to interpretation.

There is no disclosure in Graham concerning a DNA construct that does not include a promoter, and there is also simply no disclosure, teaching or suggestion in Graham to use and inverted repeat sequence that does not include a promoter.

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Amd. dated November 5, 2007
Reply to Office Action of June 6, 2007

If the examiner continues to maintain this position that claims 17 and 18 read on a promoter that lies outside the inverted repeat sequence when the DNA is limited to only an inverted repeat sequence (and optionally a spacer internal to the inverted repeat sequence) by the closed "consists of" language, then the examiner is requested to elaborate how such an interpretation is justifiable when it contravenes the USPTO's interpretation and usage of the art recognized terms "consists of" or "consisting of". The examiner's position here is simply untenable.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested.

Favorable consideration and early allowance are earnestly urged.

Respectfully submitted,

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